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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,573	07/20/2001	Andreas Kaplan	1-15407	2213

7590 08/27/2003

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EXAMINER

KUMAR, SHAILENDRA

ART UNIT PAPER NUMBER

1621

DATE MAILED: 08/27/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/909,573</b>	Applicant(s) <b>Kaplan et al</b>	Examiner <b>Shailendra Kumar</b>	Art Unit <b>1621</b>	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on Jul 25, 2003

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 11-14 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 11-14 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____	6) <input type="checkbox"/> Other: _____

Art Unit: 1621

## **DETAILED ACTION**

This office action is in response to applicants' communication filed in paper # 9, on 7/25/03.

Claims 11-14 are pending in this application. Claims 1-10 have been canceled.

Objection to claims 11-14 is hereby withdrawn subsequent to applicants' amendment.

### ***Claim Rejections - 35 U.S.C. § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by della Valle et al(US 5,506,224).

della Valle et al, in column 4, line 45, and column 5, line 1-2, anticipates instant claims, when R<sub>1</sub>CO is acyl radical of benzoic acid. Claiming cross linker for polymer is no more than a preamble, and the claim still reads on the compound. With respect to claim 13, compound is anticipatory, regardless of the process of making. With respect to claim 14, the claim still reads on mixture of two same compounds, which again are anticipated.

### ***Claim Rejections - 35 U.S.C. § 103***

Art Unit: 1621

3. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over della Valle et al.

Instant claims are directed to a cross linker for polymer comprising a beta hydroxyalkylamide of formula of claim 10, and mixture of two such compounds(see claim 14).

della Valle has been described supra. In short, the reference is teaching structurally same compound as claimed in herein, see for example, column 4, line 45, and column 5, line 1-2. The difference between the reference and herein claimed subject matter is that the reference has not made the claimed compound.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use the della Valle reference to make the instant claimed compound, because the reference expressly suggests that  $R_1CO$  is acyl radical of benzoic acid, and when so substituted in the formula of line 45, column 4, instant claimed compound can be obtained, with the reasonable expectation of achieving successful pharmaceutical composition, absent evidence to the contrary. Inasmuch as the claim language “crosslinker for polymer” is no more than a preamble, the claims still reads on the compounds claim and hence are prima facie obvious.

No claim is allowed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S.Kumar whose telephone number is (703)-308-4519. The examiner can normally be reached on Monday to Friday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Friday.

Art Unit: 1621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703)-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1235.

S.Kumar

8/5/03



SHAILENDRA KUMAR  
PRIMARY EXAMINER  
GROUP 1200  
1621